

**REMARKS**

The pending claims are 23-52.

The Examiner's allowance of Claims 26-30 and 47, and the statement that Claims 41, 51 and 52 would be allowable if amended to overcome the pending rejections under 35 U.S.C. §112, second paragraph, are gratefully acknowledged.

Claims 31, 32, 34 and 41 are amended herein. Support for the amendments may be found, for example, at paragraph 00029 of the specification as filed. Care has been taken to ensure that no new matter has been added. Entry of the amendments is requested.

Turning now to the Office Action, reconsideration is respectfully requested in view of the amendments herein and the following remarks.

**I. Claim Rejections under 35 U.S.C. §112, Second Paragraph**

Claims 34, 41, 51 and 52 are rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for reading upon one treating element.

Claims 34 and 41 are amended herein to recite "at least two treating elements". Claims 51 and 52 depend from Claim 41. Similar amendments are also made to Claims 31 and 32.

Accordingly, Applicants request that this rejection be withdrawn.

**II. Claim Rejections under 35 U.S.C. §102(b)**

Claims 23-25, 31, 32, 38, 40, 43-45, 50 and 52 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Tokita et al. (U.S. Patent No. 4,584,991; herein "Tokita").

Applicants respectfully traverse the rejection on the grounds that Tokita fails to teach all of the elements of the rejected claims, and because Tokita fails to provide an enabled disclosure.

Tokita teaches a solid carrier for applying therapeutic radiation internally via a bodily orifice (col. 1, line 10) such as a nasal or ear channel (col. 4, line 20), or the uterus (col. 5, line 11). The carrier comprises channels (26) into which radiation sources (28) are inserted. The focus of Tokita is on the solid carrier, and the radiation sources (28) are only briefly described (col. 4, lines 49-63). The radiation sources according to Tokita appear to comprise cylindrical sleeves (30) strung on a wire (32) with a plastic coating (34) that maintains the spacing of the sleeves, the whole being inserted into a plastic tube (36). The radiation sources are adapted for insertion into the smooth, hard, wide-radius, solid curved channels of the carrier (**Fig. 1**).

Tokita does not disclose a radiation source for endovascular radiation treatment. Nor does Tokita teach or suggest that the radiation source disclosed is suitable for insertion into anything other than the solid carrier of the invention. In particular, there is no teaching or suggestion that the radiation sources disclosed would be sufficiently flexible, sufficiently small, or otherwise be suitable, for endovascular treatment by insertion into a blood vessel.

The carrier taught by Tokita is adapted for insertion into bodily orifices that have a significantly larger diameter than a typical blood vessel, and the radiation source contemplated by Tokita (12, 14) would be understood by one of ordinary skill to

have much larger dimensions than a radiation source suitable for endovascular radiation treatment.

Further, the radiation source taught by Tokita does not comprise an element that is equivalent to the elongated container of the present invention, as exemplified by Claim 23. The elongated container of the present invention is a self-supporting structure ("container") as distinct from a mere coating. The elongated container of the present invention is a self-supported structure with the dual function of holding the at least two seeds together in a single radiation source and, simultaneously, providing sufficient flexibility of the source to render the source useful in endovascular radiation treatment. In contrast, the radiation source of Tokita comprises cylindrical sleeves strung on a wire-like member enclosed by a plastic coating (34). The coating disclosed by Tokita exclusively serves to retain the spacing of the cylindrical sleeves (30) (col. 4, lines 58-59) and is not taught as holding the entire source together, a function that is instead fulfilled by the wire-like element (32). Tokita therefore does not teach an element that is equivalent to the elongated container of the present invention.

Tokita therefore fails to disclose all of the elements of the rejected claims, and cannot anticipate them. The present invention is distinguished from Tokita in at least (i) that Tokita fails to disclose an "elongated container", and (ii) that Tokita fails to disclose a radiation source suitable for endovascular treatment.

Further, in order to anticipate, a reference must contain an enabling disclosure. Chester v. Miller, 906 F.2d at 1576

n.2, 15 U.S.P.Q.2d at 1336 n.2 (Fed. Cir. 1990). One of ordinary skill in the art, upon reviewing Figs 1 and 3, and col. 4, lines 49-63, of Tokita, which relates exclusively to radiation sources for insertion into a carrier for radiation treatment of bodily orifices, would not glean sufficient teaching to permit construction of the radiation source capable of use in endovascular treatment according to the present invention. The disclosure of Tokita is simply not enabling with respect to the presently claimed radiation source for endovascular radiation treatment, and therefore cannot anticipate the rejected claims.

In view of the above remarks, Applicants respectfully request reconsideration and withdrawal of the rejection.

**III. Claim Rejections under 35 U.S.C. §103(a)**

Claims 34, 36, 37, 39 and 48 are rejected as being allegedly unpatentable for obviousness over Tokita.

Claims 33, 35, 42 and 46 are rejected as being allegedly unpatentable for obviousness over Tokita in view of Liprie (U.S. Patent No. 5,857,956).

Applicants respectfully traverse both rejections on the grounds that Tokita is not an enabling reference, and not all of the elements of the rejected claims are taught by Tokita, as set forth above. Liprie fails to remedy the deficiencies noted in Tokita.

Further, one of ordinary skill would have had no motivation to combine the teachings of Tokita and Liprie because Tokita teaches radiation treatment of bodily orifices and does not teach or suggest endovascular radiation treatment. For a

similar reason, one of ordinary skill would not have had a reasonable expectation of success in combining the references.

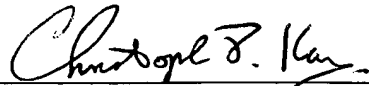
With respect to Claims 33, 35, 42 and 46, Liprie is cited for sphere shaped members (705) as spacers that would improve flexibility. However, Applicants assert that one of ordinary skill would not have been motivated to make such a substitution (and would not have had a reasonable expectation of success) because the plastic coating taught by Tokita would defeat the alleged improvement in flexibility from the use of sphere shaped spacers.

With respect to Claims 34, 36 and 37, official notice is taken in the Office Action that "connecting the treating elements to the wall of the container is old and well known in the art." Applicants seasonably traverse, and respectfully request the Examiner to provide a reference to support this position. MPEP 2144.03.

In view of the above remarks, Applicants respectfully request reconsideration and withdrawal of the rejection.

As no further issues remain in this case, early issuance of the Notice of Allowance is respectfully requested.

Respectfully submitted,



Christopher J. Kay  
Reg. No. 44,820

Pendorf & Cutliff  
5111 Memorial Highway  
Tampa, Florida 33634-7356  
(813) 886-6085

Dated: August 11, 2004

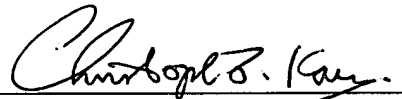
U.S. PATENT APPLICATION  
SERIAL NO.: 10/018,623  
AMENDMENT D

ATTY DOCKET: 3993.002

**CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE**

I hereby certify that a copy of the foregoing AMENDMENT D for U.S. Application No. 10/018,623 filed December 18, 2001, was deposited in first class U.S. mail, postage prepaid, addressed: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this **11<sup>th</sup> day of August**, 2004.

The Commissioner is hereby authorized to charge any additional fees that may be required at any time during the prosecution of this application, except for the issue fee, without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.



Christopher J. Kay